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EXAMINER

CHEN, ALAN S

| ART UNIT | PAPER NUMBER |
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2182

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,746

Applicant(s)

FRASER, ALEXANDER GIBSON

Examiner

Alan S. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19,21-23 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-17,19,21-23 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/20/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED FINAL ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4-9,11-17,19,21-23 and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. Pub. No. 2003/0001012 to Bermudez.
4. Per claim 1, Bermudez discloses an apparatus (a laptop computer paragraph 16), comprising: a memory for storing a network device name (the network card, e.g., the network device which is by definition a part of the laptop, e.g., "...network card 102 is removed from ESD bag and pasted on installed in the proper slot in the interior of the laptop 300", paragraph 16, has memory that electronically stores the MAC address, paragraph 10), the network device name being displayed on an exterior surface of the apparatus (paragraph 16, "...label is removed from the exterior of the ESD bag and pasted on the exterior of the laptop, 300); and an interface that may be connected to a network device (paragraph 16, laptop slot that is connected to network card, the network card being the network device), and wherein when the interface is connected to the network device, the network device name is loaded into the network device and

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utilized by the network device in communications across a network (the MAC address becomes activated to represent the entire laptop apparatus and allows communication with the network, paragraph 10, "...network card hooks up to the network".

5. Per claim 14, Bermudez discloses a method of addressing a network device (paragraph MAC address resident on network card) comprising: affixing an electronically addressable tag storing a network device name to the network device (paragraph 10, MAC address is a hardware address), the network device name being visibly apparent on a surface of the electronically addressable tag (laptop device that comprises the network card 102 has the MAC address externally pasted 16) wherein the electronic tag (MAC address) establishes a connection between the network card and network (paragraph 10, hooks up to network); loading the network device name stored in the electronically addressable tag (the MAC address is activated in the network card when the network card is in the laptop) and communicating with a network (paragraph 10).

6. Per claim 22, Bermudez discloses a method for use with one or more an addressable network devices (Fig. 1) comprising: generating a network device name which may be utilized by the network device in communications across a network (MAC address is the network device name which must be generated to be unique from any other address on the internet, paragraph 10); and storing the network device name in a tag as a digital representation of a pictorial icon that is displayed on the tag's exterior (paragraph 16, "...label 110...pasted on the exterior of the laptop" and Fig. 2, 110 and 112 are pictorial representations of the MAC address, specifically "two dimensional bar codes", paragraph 13), the tag being adapted to be physically connected to a first network device (address is in hardware, paragraph 10) such that the network device name may be loaded into the first network device and utilized to configure the first network device (the

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MAC address is activated in the network card when the network card is in the laptop, paragraph 16, and allows network to communicate with the network card, paragraph 10).

7. Per claims 2-5, 17, 19, 23 Bermudez discloses claims 1, 14 and 22 wherein the network device name being a digital representation of an alphanumeric name (paragraph 10 discloses MAC being electronically encoded, inherently digital in computer hardware; paragraph 13 discloses MAC address being alphanumeric) or pictorially icon (Fig. 2, 110 and 112 are pictorial representations of the MAC address, specifically “two dimensional bar codes”, paragraph 13). Bermudez also discloses the pictorial icon being displayed on the exterior of the apparatus (paragraph 16, “...label 110...pasted on the exterior of the laptop”).

8. Per claims 6-9, 15, 16 and 32 Bermudez discloses claims 1, 14 and 31 wherein the network device (network card 102) associates the network device name with an address on the network (MAC address is what the network uses to gain access to the laptop and vice versa), the MAC address being unique (paragraph 10). The origins of the MAC address inherently must be checked databases so that it is made unique. As Bermudez discloses, the MAC address is recorded on databases, routing tables, etc. where it MAC address is made known to other devices on the network and would causes network conflicts if not unique (paragraph 10).

9. Per claims 11-12, Bermudez discloses claim 1, wherein the interface inherently comprises a connector (paragraph 16 discloses a slot which the network card is inserted, inherently requiring a connector). The bus protocol interfacing the network card intrinsically can be of the parallel or serial type.

10. Per claims 13, 21 and 27, Bermudez discloses claims 1,14 and 22 wherein the network is an Ethernet network (paragraph 10, IEEE 802 conformity, 802.3 is Ethernet).

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11. Per claim 28, Bermudez discloses claim 1, wherein when the apparatus (laptop) is physically moved and connected with another network device (e.g., another network card is attached to it), the MAC address of the new network card would intrinsically be loaded and identify the laptop as that MAC address and communicate across the network.

12. Per claims 29 and 30, Bermudez discloses claim 14, further comprising moving the electronically addressable tag from the network device to another network device (inherently, when the network card is removed and put into another laptop computer, this other laptop computer here considered the “another network device”, the laptop would assume the MAC address of the network card) establishing an electronic connection between the another network device and the electronically addressable tag (laptop slot interfaces/connects network card); loading the network device name stored in the electronically addressable tag into the another network device (OS inherently attains MAC address) via a discovery process. MAC address is unique across the network (paragraph 10).

13. Per claims 31 and 33, Bermudez discloses claim 22, it is inherent that if the network card is removed from a current laptop and inserted into another laptop (the “second network device”), the external label (the tag) must also be removed and replaced on the other laptop. The other laptop then would activate the electronic tag associated with the external tag and use it to identify itself to the network it is attached to. The network device name, e.g., the MAC address, is displayed to a user by the label pasted to the laptop.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claim 10 is rejected under 35 USC 103(a) as being unpatentable over

Bermudez in view of Microsoft Windows 2000 (Windows 2000).

Bermudez discloses claim 1 and the laptop device (the apparatus) linking up to a network. The laptop intrinsically has a display.

Bermudez does not disclose expressly the display capable of displaying the network address that is stored in the memory of the apparatus (e.g., electronically stored on the network card 102, paragraph 10 of Bermudez).

Windows 2000 discloses the ability to display the MAC address in variety of ways, e.g., using commands *ipconfig* (see physical address under the *ipconfig* command) or the *ARP utility*.

Bermudez and Windows 2000 are analogous art because they are from the same field of endeavor where Bermudez requires an operating system to run on it, particularly one that supports network communications.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Windows 2000 as the operating system.

The suggestion/motivation for doing so would have been Bermudez invention disclosure occurred around approximately the time that Windows 2000 was in popular use, furthered the fact that windows operating system since at least Windows 98 utilized the same networking commands in all the operating systems developed by Microsoft.

Therefore, it would have been obvious to combine Bermudez with Windows for the benefit of using the most popular, widely used operating system at approximately the time of Bermudez's invention disclosure.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC
08/01/2005


KIM HUYNH
PRIMARY EXAMINER
8/2/05